

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): R.L. Hackbarth et al.
Case: 2-3-12
Serial No.: 09/886,876
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Group: 2174
Examiner: Ryan F. Pitaro

Title: Apparatus and Method for Use in Portal Service
for a Team Utilizing Collaboration Services

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Appeal 2009-000934 dated August 16, 2010, regarding the above-identified application, Applicants (hereinafter “Appellants”) respectfully request a rehearing under 37 C.F.R. § 41.52(a)(2) based upon the recent Federal Circuit decision in *King Pharmaceuticals Inc. v. Eon Labs Inc.*, 95 USPQ2d 1833 (Fed. Cir. Aug. 2, 2010).

Appellants note that, in the Principles of Law section of the Decision at page 4, last paragraph, the Board states that “[o]ur reviewing court has held that non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art,” and cites two cases in support of this proposition: *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004) and *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983).

In *King Pharmaceuticals*, the Federal Circuit considered whether to assign patentable weight to “printed matter” (or more broadly descriptive matter) limitations, which is the very issue addressed by the Board in the Decision. See the Decision at page 3, last paragraph. Yet, notably absent from the Decision is any citation to *King Pharmaceuticals*, which was decided only two weeks prior to the mailing of the Decision on Appeal, and thus Appellants believe that *King Pharmaceuticals* may not have been considered by the Board.

Appellants initially note that, in *King Pharmaceuticals*, the Federal Circuit expressly stated that, even where “the printed matter is not independently patentable, . . . the limitation must not be excised from the claim. . . . ‘[T]he board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable.’” *King Pharmaceuticals*, 95 USPQ2d at 1842 (quoting *Gulack*, 703 F.2d at 1385, 217 USPQ at 403). See also *Gulack*, 703 F.2d at 1385, 217 USPQ at 403 (“Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter.”)

Moreover, in *King Pharmaceuticals*, 95 USPQ2d at 1842, the Federal Circuit stated (with all italics, bracketing and parentheses in original and with underlining added):

In an analogous context, we have held that “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (alterations added). In such cases, . . . the relevant question is whether “there exists any new and unobvious functional relationship between the printed matter and the substrate.” *Id.* at 1386 (citing *In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969)). The rationale behind this line of cases is preventing the indefinite patenting of known products by the simple inclusion of novel, yet functionally unrelated limitations. *See In re Ngai*, 367 F.3d at 1339.

Although these “printed matter” cases involved the addition of printed matter, such as written instructions, to a known product, we see no principled reason for limiting their reasoning to that specific factual context. *See In re Ngai*, 367 F.3d at 1338-39; *In re Gulack*, 703 F.2d at 1385-87. Rather, we believe that the rationale underlying these cases extends to the situation presented in this case, wherein an instructional limitation is added to a method, as opposed to a product, known in the art. Thus, the relevant inquiry here is whether the additional instructional limitation of claim 21 has a “new and unobvious functional relationship” with the

known method of administering metaxalone with food. See *In re Ngai*, 367 F.3d at 1338 (quoting *In re Gulack*, 703 F.2d at 1386). . . .

Thus, *King Pharmaceuticals* holds that there are two different standards for evaluating whether to assign patentable weight to “printed matter” (or more broadly descriptive matter) limitations in a product claim and in a method claim. For a product claim, such as the claims at issue in *Ngai* and *Gulack*, the relevant question is whether there exists any new and unobvious functional relationship between the limitation and the substrate. By contrast, for a method claim, such as that which was at issue in *King Pharmaceuticals* and claim 1 of the present application, the relevant inquiry is whether there exists any new and unobvious functional relationship between the limitation and the method.

In the Analysis section of the Decision, at page 5, second paragraph, the Board states (with emphasis added):

The pertinent question is whether an otherwise anticipated or obvious method becomes non-obvious because it includes a step of displaying a visual representation of a time axis on a substrate. Where printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Thus, the relevant inquiry here is whether the visual representation of claim 1 has a new and unobvious functional relationship with the substrate (e.g., electronic display).

The Board then determines that the “relationship between the visual representation and the display is not functional,” and “[t]he ‘visual representation’ is therefore non-functional descriptive material that is not entitled to patentable weight.” See the Decision at page 5, last paragraph, first and last sentences.

Given that claim 1 is directed to a method rather a product, it appears that the Board has applied the incorrect standard. The relevant inquiry here is not “whether the visual representation of claim 1 has a new and unobvious functional relationship with the substrate” (i.e., whether the “relationship between the visual representation and the display” is functional), as stated by the Board. Rather, the relevant inquiry is whether the visual representation of claim

1 has a new and unobvious functional relationship with the method recited in the remainder of claim 1.

Appellants respectfully disagree with the Board's findings in the Decision at page 5, last paragraph (with bracketing in original):

The visual representation of the time axis in no way transforms the process of displaying data on the display device. Irrespective of whether the substrate displays a time axis, the actual method of displaying data is the same. In other words, the “visual representation comprises a time axis” limitation “in no way depends on the [method], and the [method] does not depend on the [‘visual representation’ limitation].”

Claim 1 recites a “method for use in providing a Web team portal in a collaborative system” which includes a step of “dynamically displaying a visual representation.” Claim 1 further specifies that “said visual representation comprises a time axis” having certain characteristics. Appellants respectfully assert that the limitation specifying that the visual representation comprises a time axis transforms the step of dynamically displaying a visual representation, in that the limitation (visual representation comprises a time axis) depends on the step (dynamically displaying a visual representation) and vice versa.

In fact, the functional relationship between the limitations which specify characteristics of a visual representation and the claimed “method for use in providing a Web team portal in a collaborative system” is closely analogous to that which was accorded patentable weight in *Gulack*, and clearly distinct from the instructional limitations at issue in both *Ngai* and *King Pharmaceuticals*.

Gulack concerned an instance where “the printed matter and the circularity of the band were interrelated, so as to produce a new product useful for ‘educational and recreational mathematical’ purposes” and “the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result,” as described in *Ngai*, 367 F.3d at 1339, 70 USPQ2d at 1864.

Similarly, claim 1's recitations of a step of “dynamically displaying a visual representation” and of “said visual representation comprises a time axis” are interrelated so as to

produce a new “method for use in providing a Web team portal in a collaborative system.” Moreover, the limitation “said visual representation comprises a time axis” requires the step of “displaying a visual representation” in order to produce the claimed method, and the step of “displaying a visual representation” requires the further limitation wherein “said visual representation comprises a time axis” in order to produce the claimed method.

By contrast, *Ngai* concerns a case which “is dissimilar from *Gulack*” in that “addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band” and that “the printed matter in no way depends on the kit, and the kit does not depend on the printed matter.” *Ngai*, 367 F.3d at 1339, 70 USPQ2d at 1864. Similarly, in *King Pharmaceuticals*, 95 USPQ2d at 1842, the Federal Circuit held that “[i]nforming a patient about the benefits of a drug in no way transforms the process of taking the drug with food. Irrespective of whether the patient is informed about the benefits, the actual method, taking metaxalone with food, is the same.”

Appellants further note that instructional limitations, such as those which were at issue in *Ngai* and *King Pharmaceuticals*, raise specific concerns which are not implicated by other sorts of limitations, such as those in *Gulack* and the present case. As noted by the Federal Circuit in *King Pharmaceuticals*, 95 USPQ2d at 1842, “the rationale behind this line of cases is preventing patenting of known products by the simple inclusion of novel, yet functionally unrelated limitations.”

More particularly, as described in *Ngai*, 367 F.3d at 1339, 70 USPQ2d at 1864, ascribing patentable weight in cases such as *Ngai* and *King Pharmaceuticals* where “[a]ll that the printed matter does is teach a new use for an existing product” could result in an undesirable situation where “anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product. This was not envisioned by *Gulack*,” and would not result from allowing the claims of the present application.

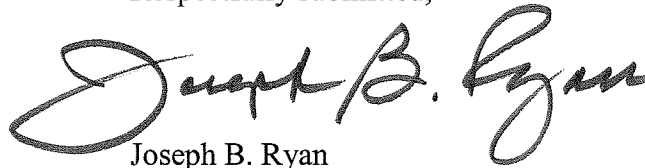
With regard to claim 10, Appellants respectfully assert that the functional relationship between the limitation “wherein said visual representation comprises a time axis” and the recited “means for dynamically displaying a visual representation” is clearly analogous to that discussed above with regard to claim 1, and thus claim 10 is similarly patentable.

With regard to claim 18, Appellants respectfully assert that the functional relationship between the limitation “wherein said visual representation comprises a time axis” and the recited “visual display unit to dynamically display a visual representation” is clearly analogous to that discussed above with regard to claim 1, and thus claim 18 is similarly patentable.

The dependent claims are patentable at least by virtue of their respective dependencies from the independent claims.

For the reasons identified hereinabove, as well as the reasons discussed in the Appeal Brief and Reply Brief previously filed by Appellants in the present application, Appellants believe that the present application is in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, reading "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" clearly legible.

Date: October 18, 2010

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